

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant: | Robert F. Sheppard | Examiner: | Neil R. Kardos |
| Serial No.: | 10/763,072 | Group Art Unit: | 3623 |
| Filed: | January 21, 2004 | Docket No.: | 200901410-1 |
| Title: | MANAGING INFORMATION TECHNOLOGY (IT) INFRASTRUCTURE OF AN ENTERPRISE USING A CENTRALIZED LOGISTICS AND MANAGEMENT (CLAM) TOOL | | |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.131

Sir/Madam:

I, Robert F. Sheppard, declare as follows:

1. I am the named inventor of the subject matter described and claimed in the above-identified U.S. Patent Application Serial No. 10/763,072 filed January 21, 2004.

2. I was an employee of Electronic Data Systems Corporation at the time of the invention described and claimed in the above identified U.S. Patent Application Serial No. 10/763,072 filed January 21, 2004.

3. I assigned all right, title, and interest in and to the invention described and claimed in the above identified U.S. Patent Application Serial No. 10/763,072 filed January 21, 2004 to Electronic Data Systems Corporation, where the chain of title passed from me to Electronic Data Systems Corporation, then to Electronic Data Systems, LLC, and then to Hewlett-Packard Development Company, LP.

4. I make this Declaration in support of the patentability of the claims of U.S. Patent Application Serial No. 10/763,072 filed January 21, 2004 in response to the Final Office Action mailed January 20, 2011 rejecting claims 1-3, 6, 7, 9, 16-19, 22, 23, and 25 under 35 U.S.C. § 102(e) as being anticipated by O'Connor et al. U.S. Patent Application Publication No. 2005/0138074 ("O'Connor"), and rejecting claims 4, 5, 8, 20, 21, and 24 under 35 U.S.C. § 103(a) as being unpatentable over O'Connor in view of Gullotta et al. U.S. Patent No. 6,985,955, and rejecting claims 10 and 26 under 35 U.S.C. § 103(a) as being unpatentable over O'Connor in view of Official Notice, and rejecting claims 11-14 and 27-30

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under 35 U.S.C. § 103(a) as being unpatentable over O'Connor in view of Northcutt U.S. Patent Application Publication No. 2003/0126001. For purposes of the Final Office Action mailed January 20, 2011, the earliest prior art date for U.S. Patent Application Publication No. 2005/0138074 to O'Connor et al. is its filing date of December 22, 2003.

5. Prior to the December 22, 2003 filing date of U.S. Patent Application Publication No. 2005/0138074 to O'Connor et al., cited by the Office Action as referenced above, I conceived the above-identified and claimed subject matter of U.S. Patent Application Serial No. 10/763,072. The claimed subject matter was constructively reduced to practice via the filing of U.S. Patent Application Serial No. 10/763,072 on January 21, 2004. As factual evidence of my conception prior to December 22, 2003, attached hereto and incorporated by reference herein, are Exhibits A-C.

6. Exhibit A is an e-mail correspondence from Chad Terrell at Baker Botts L.L.P. in Dallas, Texas to Robert F. Sheppard. Exhibit B is a draft patent application, of U.S. Patent Application Serial No. 10/763,072, attached to the e-mail correspondence of Exhibit A. Exhibit C are draft drawings, for U.S. Patent Application Serial No. 10/763,072, attached to the e-mail correspondence of Exhibit A. The e-mail correspondence and the attached draft of the patent application and drawings were produced prior to the earliest date for U.S. Patent Application Publication No. 2005/0138074 to O'Connor et al., which is its filing date of December 22, 2003. The draft patent application of Exhibit B and the drawings of Exhibit C describe the subject matter of the present patent application and support that the claimed invention of the present patent application was conceived prior to December 22, 2003.

7. After conceiving the claimed invention of the present application, I diligently worked on the patent application from just prior to December 22, 2003 to January 21, 2004 and I diligently filed U.S. Patent Application Serial No. 10/763,072 on January 21, 2004, as described in Paragraphs 8-13. As factual evidence of my diligence from just prior to December 22, 2003 to January 21, 2004, I declare as stated in Paragraphs 8-12 and attach hereto and incorporate by reference herein, Exhibits D and E.

8. During the period from just prior to December 22, 2003 to January 21, 2004, I diligently reviewed the draft patent application and identified possible issues with the draft patent application. I, also, interfaced with the law firm Baker Botts L.L.P. in Dallas, Texas to diligently resolve these and other issues with the draft patent application.

9. Exhibit D is e-mail correspondence between Chad Terrell at Baker Botts L.L.P. in Dallas, Texas and me, Robert F. Sheppard. This e-mail correspondence occurs during the period from December 18, 2003 to January 12, 2004. As indicated in the e-mail correspondence from me, Robert F. Sheppard, to Chad Terrell dated January 06, 2004 at 8:24 AM, I suffered an illness and had a resulting short stay in the hospital during the period from December 18, 2003 to January 6, 2004. As of January 6, 2004 I was back and ready to continue.

10. In Exhibit D, in the three e-mails between Chad Terrell at Baker Botts L.L.P. in Dallas, Texas and me, Robert F. Sheppard, on January 6, 2004, I diligently worked with Chad Terrell to resolve an issue with the acronym PRE (Platform Re-Engineering). In the e-mail correspondence from me, Robert F. Sheppard, to Chad Terrell dated January 06, 2004 at 8:24 AM, I suggested using EDS (Electronic Data Systems) instead of PRE. In the e-mail correspondence from Chad Terrell to me, Robert F. Sheppard, dated January 06, 2004 at 15:55, Chad Terrell replied that they typically like to leave references to the company, e.g., EDS, out of the application. In the e-mail correspondence from me, Robert F. Sheppard, to Chad Terrell dated January 06, 2004 at 11:00 AM, I suggested using the acronym SED (Service Enablement and Deployment), which was used in the final draft of the application filed on January 21, 2004.

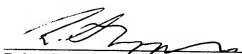
11. During the period from just prior to December 22, 2003 to January 21, 2004 I worked as a Team Leader for a team known as the "Tools Team". During this time my Tools Team was responsible for Training, Support, Maintenance, and Enhancements. I provided solution stewardship and executed the role of Solutions Architect (Innovator, Designer, Technical Lead, Lead Developer, and Problem Manager) while working toward actual reduction to practice of the subject matter of U.S. Patent Application Serial No. 10/763,072.

12. During the period from January 6, 2004 to January 20, 2004 I further reviewed the more than 100 page draft patent application, including the specification, claims, and figures. I signed copies of the formal papers on January 20, 2004 and I dispatched the signed copies of the formal papers on January 21, 2004. Exhibit E is e-mail correspondence between Chad Terrell at Baker Botts L.L.P. in Dallas, Texas and me, Robert F. Sheppard, evidencing the dispatching of signed formal papers on January 21, 2004.

13. A final draft of the patent application was filed as U.S. Patent Application Serial No. 10/763,072 on January 21, 2004 by Christopher W. Kennerly, registration number 40,675, of Baker Botts L.L.P.

14. It is therefore respectfully submitted that the subject matter of the present application, U.S. Patent Application Serial No. 10/763,072, was conceived prior to December 22, 2003 and the patent application was diligently worked on from just prior to December 22, 2003 to January 21, 2004 and diligently filed with the U.S.P.T.O. Thus, the U.S. Patent Application Publication No. 2005/0138074 to O'Connor et al. reference should be removed as a reference under 35 U.S.C. § 102(e).

15. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or patent issued thereon.


Robert F. Sheppard

3/6/2011
Date